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Remarks:

*Amendments to the claims:*

Claims 1 and 6-50 are pending in this application, with claims 28-50 currently withdrawn from consideration. By this Amendment, claims 1, 27 and 31 are amended. Claim 27 is amended to correct a typographical error. Claim 31 is amended to maintain consistency with claim 1.

No new matter is added to the application by this Amendment. Support for the features added to claims 1 and 31 can be found in the specification, as originally filed, at, for example, paragraph [0044] of U.S. Patent Publication No. 2008/0269102 for the present application.

*Regarding allowable claim 27:*

Applicants thank the Examiner for the indication that claim 27 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Regarding the rejection of claims 1, 7 and 8 under 35 USC 102(b) as allegedly being anticipated by U.S. Patent Publication No. 2004/0248762 to McGee et al. (hereinafter "McGee"):*

Applicants traverse the Examiner's rejection of the foregoing claims as allegedly being anticipated by McGee.

Prior to discussing the relative merits of the Examiner's rejection, the applicant points out that unpatentability based on "anticipation" type rejection under 35 USC 102(b) requires that the invention is not in fact new. See *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack of novelty (often called 'anticipation') requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee").

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Anticipation requires that a *single reference* [emphasis added] describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. See, *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The principle of "inherency," in the law of anticipation, requires that any information missing from the reference would nonetheless be known to be present in the subject matter of the reference, when viewed by persons experienced in the field of the invention. However, "anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation, [or the reference] cannot inherently anticipate the claims." *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 [62 USPQ2d 1865] (Fed. Cir. 2002); *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency).

Thus when a claim limitation is not explicitly set forth in a reference, evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co.*, 948 F.2d at 1268. It is not sufficient if a material element or limitation is "merely probably or possibly present" in the prior art. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002). See also, *W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation "cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references"); *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

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The Patent Office acknowledges that McGee is silent on the decomposition properties for the chemical recited in claim 1 and an odor (see page 3 of the Office Action). The Patent Office alleges that the chemical used in the process of making the composition is a species in Applicants' genus and that it would be expected to have the same properties regarding odor or decomposition as those claimed by Applicants because the chemical properties are inherent. Applicants respectfully disagree with these allegations by the Patent Office.

The present invention requires a process for preparing compositions which provide upon activation an olfactory compound by incorporating a compound of formula (I), followed by activation by cleaving the compound of formula (I) by hydrolysis followed by photoisomerization.

McGee discloses a fragrance composition comprising compound GR-85-2666/000 having a malodor counteracting effect and a fragrance (see claims 26 and 28 of McGee). McGee also discloses that compound GR-85-2666/000 is mixed with a fragrance, resulting in a fragrance composition. Thus, the only fragrance making process disclosed in McGee is the admixture of a compound having malodor counteracting effect with a fragrance.

Thus, nowhere does McGee disclose a process for preparing compositions which provide upon activation an olfactory compound comprising the steps of incorporating into the composition a compound of formula (I) as precursor for olfactory compounds compound and cleaving the compound of formula (I) by hydrolysis followed by photoisomerization as required by claim 1.

Because the features of independent claim 1 are neither taught nor suggested by McGee, McGee cannot anticipate, and would not have rendered obvious, the features specifically defined in claim 1 and its dependent claims.

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For at least these reasons, claims 1, 7 and 8 are patentably distinct from and/or non-obvious in view of McGee. Reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. 102(b) are respectfully requested.

*Regarding the rejection of claims 1, 6, 8, 9 and 11-17 under 35 USC 102(b) as allegedly being anticipated by Tetrahedron, 1997, Vol. 53, No. 28, pages 9477-9486) to Bunce et al. (hereinafter "Bunce"):*

Applicants traverse the Examiner's rejection of the foregoing claims as allegedly being anticipated by Bunce.

The Patent Office acknowledges that Bunce does not disclose the chemical's decomposition products or odor properties (see page 4 of the Office Action). The Patent Office alleges (a) that it would be expected to have properties identical to the same chemicals in the Applicants' genus because the chemical (allegedly listed as number 16) of Bunce is a species in the Applicants' claimed genus, and (b) the chemical's properties are inherent to those in the genus. Applicants respectfully disagree with these allegations by the Patent Office.

Bunce discloses a tandem dealkoxycarbonylation-Michael addition-based ring expansion sequence for the preparation of 2,2-dialkyl-3-oxocyclohexanecarboxylic esters, lactones and lactams that may be useful as building blocks for organic synthesis (see page 9477 of Bunce). However, there is no teaching in Bunce that the compound being cleaved by hydrolysis followed by photoisomerization to release an olfactory compound.

Thus, Bunce fails to disclose a process for preparing compositions which provide upon activation an olfactory compound comprising the steps of incorporating into the composition a compound of formula (I) as precursor for olfactory compounds compound and cleaving the compound of formula (I) by hydrolysis followed by photoisomerization as required by claim 1.

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Because the features of independent claim 1 are neither taught nor suggested by Bunce, Bunce cannot anticipate, and would not have rendered obvious, the features specifically defined in claim 1 and its dependent claims.

For at least these reasons, claims 1, 6, 8, 9 and 11-17 are patentably distinct from and/or non-obvious in view of Bunce. Reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. 102(b) are respectfully requested.

*Regarding the rejection of claims 1-26 under 35 USC 102(a) as allegedly being anticipated by Bioorganic Chemistry, 1999, Vol. 27, pages 339-350) to Russell et al. (hereinafter "Russell"):*

Applicants traverse the Examiner's rejection of claim 1-26 as allegedly being anticipated by Russell.

In view of the previous cancelation of claims 2-5, this rejection is moot with respect to those claims.

The Patent Office acknowledges that Russell does not disclose the odor and decomposition of the chemical (see page 6 of the Office Action). The Patent Office alleges that Russell discloses that the chemical is of a type used in the perfume industry and the decomposition of the chemical, found in the Applicants' genus, would be expected to have the same decomposition properties claimed by Applicants. Applicants respectfully disagree with these allegations by the Patent Office.

Russell discloses a photochemical cyclodimerization of Cinnamic acid derivatives (page 339 of Russell). Beside several other compounds the preparation of butane 1,4-di-(2-methoxycarbonyloxy)cinnamate is disclosed in the Experimental part of the publication (see page 348 of Russell). However, there is no teaching in Russell that the compound being cleaved by hydrolysis followed by photoisomerization to release an olfactory compound.

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Thus, Russell fails to disclose a process for preparing compositions which provide upon activation an olfactory compound comprising the steps of incorporating into the composition a compound of formula (I) as precursor for olfactory compounds compound and cleaving the compound of formula (I) by hydrolysis followed by photoisomerization as required by claim 1.

Because the features of independent claim 1 are neither taught nor suggested by Russell, Russell cannot anticipate, and would not have rendered obvious, the features specifically defined in claim 1 and its dependent claims.

For at least these reasons, claims 1 and 5-26 are patentably distinct from and/or non-obvious in view of Russell. Reconsideration and withdrawal of the rejections of the claims under 35 U.S.C. 102(a) are respectfully requested.

*Regarding withdrawn claims 28-50:*

Applicants respectfully submit that because claims 1 and 5-27 are in condition for allowance for the reasons set forth above, claims 38-50 should be rejoined and similarly allowed. Thus, withdrawal of the Restriction/Election Requirement and rejoinder of claims 28-50 are respectfully requested.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience.

The early issuance of a *Notice of Allowability* is solicited.

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**PETITION FOR A ONE-MONTH EXTENSION OF TIME**

Applicants respectfully petition for a one-month extension of time in order to permit for the timely entry of this response. The Commissioner is hereby authorized to charge the fee to Deposit Account No. 14-1263 with respect to this petition.

**CONDITIONAL AUTHORIZATION FOR FEES**

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully Submitted;



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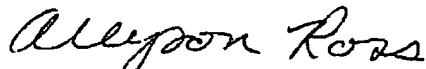


Date:


Tel: 212 808-0700

**CERTIFICATE OF TELEFAX TRANSMISSION UNDER 37 CFR 1.8**

I certify that this document, and any attachments thereto, addressed to the:  
"Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" is being  
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Allyson Ross



Date

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